

Serial No.: 10/540,805

### **REMARKS**

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims is less than originally filed.

#### **Request for Telephone Interview**

Applicants kindly request the Examiner to contact the undersigned at (847) 490-1400 to schedule a telephone interview, to discuss the merits of this Patent Application.

#### **Amendment to the Claims**

Claim 1 has been amended for clarity in view of the rejection under 35 U.S.C. §112. New independent Claim 19 has been added and finds support in original Claim 1, the figures, and at page 9, penultimate paragraph, of the Substitute Specification. No new matter has been added to the claims by this Amendment.

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**Claim Rejections - 35 U.S.C. §112**

The rejection of Claims 1-18 under 35 U.S.C. §112, is rendered moot by the above Amendment.

**Claim Rejections - 35 U.S.C. §102**

The rejection of Claims 1-7, 11-15, 17, and 18 under 35 U.S.C. §102(b) as anticipated by WO '238 is respectfully traversed.

WO '238 teaches a shoulder 4 resting against a seating surface 22, and a sealing ring 18 around the receptacle 11 opening. However, WO '238 does not teach a clearance forming an adjusting space between a shoulder of a base element and a side of a chisel holder, where a portion of the sealing element bridges the clearance, as in Applicants' claimed invention.

The Office Action refers to sealing element 18 in WO '238 as Applicants' sealing element that partially closes the receptacle opening, but identifies the recited "clearance" as groove 16. Applicants respectfully disagree with the assertion that the groove 16 of WO '238 is equivalent to Applicants' clearance that forms an adjusting space, and Applicants also note it is the second sealing member 17, not sealing member 18, that is in groove 16.

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The apparatus of WO '238 is structurally different from Applicants' claimed invention. Because of this difference, the Office Action requires applying two different sealing elements to obtain all limitations of Applicants' recited sealing member.

WO '328 does not anticipate Applicants' claimed invention because WO '328 teaches neither Applicants' recited clearance forming an adjusting space between the base element shoulder and a side of the chisel holder nor the recited sealing element partially closing the opening and having a portion shaped to bridge the clearance.

For at least these above reasons favorable reconsideration and withdrawal of the rejection are respectfully requested.

New Claim 19 recites a sealing element seated in the bezel and including a portion extending out from the bezel and having a shape that bridges the clearance. WO '238 does not provide or allow for such a sealing element, as the sealing element 18 is squeezed into bezel 14 by the directly contacting surfaces 22 and 4.

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### **Claim Rejections - 35 U.S.C. §103**

The rejection of Claims 8-10 and 16 under 35 U.S.C. §103(a) as being unpatentable over WO '238 in view of Wrulich, U.S. Patent 4,456,306, in view of GB 2055434, is respectfully traversed. Claims 8-10 and 16 depend from Claim 1 and are patentable for at least the same reasons as discussed above.

Furthermore, Applicants fail to appreciate how the alleged sealing lips of the secondary references would be useful or practical in the groove 16 of WO '238, as the symmetrical groove 16 is about halfway down the pin 5.

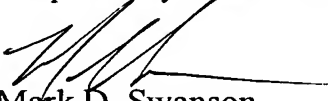
### **Conclusion**

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed or resolved in this response, the undersigned attorney again requests a telephone interview with the Examiner.

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

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Respectfully submitted,

  
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